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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,013	05/10/2001	Moritsugu Nishida	L7016.01112	3988

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EXAMINER

MEUCCI, MICHAEL D

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/852,013	NISHIDA, MORITSUGU	
	Examiner	Art Unit	
	Michael D. Meucci	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 May 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) 1 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 May 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892) *
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 1 objected to because of the following informalities: Applicant specifies "said communication apparatus" on line 13 of the claim. Examiner believes applicant meant to specify, "said file communication apparatus" to remain consistent with what was previously disclosed on lines 7 and 10 of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

a. Claim 2 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant specifies a first signal sent after a second signal, which makes the claim unclear. It is unclear as to whether or not the applicant meant to use descriptors "first" and "second" to order the timing of the signals or to specifically assign a particular signal to each descriptor. For the purpose of applying art, it will be presumed that the later case will hold true and the "first predetermined signal" will constitute a "SEND FILE request from the computer to the telephone set" and the "second predetermined signal" will constitute an "ACCEPT FILE reply from the telephone set to the computer." Applicant must clarify the claim remembering not to introduce any new matter.

B Claims 3, 8 and 13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner as to what is meant to be disclosed as "a main portion of said telephone set." For the purposes of applying art, it will be presumed that the speaker will be located on the telephone in any position. Applicant must clarify the claim remembering not to introduce any new matter.

c. Claims 7-10 recites the limitation "A communication system according to claim 6" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim. Claim 6 specifies "A file communication apparatus" which should be referenced in the preamble of all dependent claims. Appropriate correction is required.

d. Claims 12-15 recites the limitation "A communication system according to claim 11" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim. Claim 11 specifies "A file communication unit" which should be referenced in the preamble of all dependent claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-8, 10-13, and 15 rejected under 35 U.S.C. 102(b) as being anticipated by Baratz.

a. As per claim 1 and 6, Baratz teaches: a mail server for receiving and storing a mail, to which a voice file is attached, through a network (abstract and Figures 1 & 2); a plurality of computers for receiving the mail from said mail server through said network (abstract and Figures 1 & 2); a file communication apparatus for receiving the voice file through said network (abstract and Figures 1 & 2); a plurality of telephone sets connected to said file communication apparatus, each of said telephone sets being disposed in correspondence with one of said computers (abstract and Figures 1 & 2); said file communication apparatus includes management means for storing information about a corresponding relationship between telephone number of said telephone sets and network addresses of said computers (lines 36-38 of column 6); receiving means for receiving the network address and the voice file which are transmitted from one of said computers (abstract, Figures 1 & 2, and 20-38 of column 6); storing means for storing the voice file received by said receiving means (abstract and Figures 1 & 2); conversion means for converting the stored voice file into a voice signal (abstract); transmitting means for transmitting the voice signal (abstract and Figures 1 & 2); and control means for obtaining the telephone number corresponding to the received network address based on the relationship in said management means, and for controlling said transmitting means to transmit the voice signal to said telephone set corresponding to the obtained telephone number (lines 20-38 of column 6).

b. As per claim 2, 7, and 12, Baratz teaches: said control means controls said transmitting means to start transmitting the voice signal to said telephone set by

receiving a first predetermined signal from said telephone set after transmitting a second predetermined signal to said telephone set (lines 38-44 of column 5).

c. As per claim 3, 8, and 13, Baratz teaches: said telephone set has a speaker in a main portion of said telephone set (lines 39-43 of column 4 and lines 46-51 of column 9); said control means controls said transmitting means to transmit the voice signal to said telephone set by receiving a request signal from said computer, so that said telephone set outputs sound of the voice signal from said speaker (abstract, lines 39-43 of column 4, and lines 46-51 of column 9);

d. As per claim 5, 10, and 15, Baratz teaches: said control means deletes the voice file stored in said storing means, by receiving a predetermined signal from said telephone set (lines 12-20 of column 8).

e. As per claim 11, Baratz teaches: a telephone set (abstract and Figures 1 & 2); receiving means for receiving a voice file through a network (abstract); storing means for storing the received voice file (abstract and Figures 1 & 2); conversion means for converting the stored voice file into a voice signal (abstract and Figures 1 & 2); request means for transmitting a signal for requesting to connect a telephone line to said telephone set, to said telephone set by receiving the voice file (abstract and lines 38-44 of column 5); transmitting means for transmitting the converted voice signal to said telephone set (abstract); and transmitting means for transmitting the converted voice signal to said telephone set; and control means for controlling said transmitting means to transmit the voice signal to said telephone set by receiving a predetermined signal from said telephone set (lines 38-44 of column 5).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 9, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Baratz as applied to claims 1, 6, and 11 respectively above, in view of Kennedy (U.S. 6,456,715 B1).

As per claims 4, 9, and 14, Baratz fails to teach: wherein said control means controls said transmitting means to retransmit the voice signal to said telephone set by receiving a predetermined signal from said telephone set during transmission of the voice signal by said transmitting means or after transmitting the voice signal.

However, Kennedy discloses: "One of the routines might be, for example, a voice mail retrieval routine that retrieves stored voicemail messages that a modem stored when in a voicemail telephony mode. Continuing the example, once the key pad selects the voicemail retrieval routine, the routine replays the stored messages over the telephone," (lines 57-62 of column 3).

It would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to have said control means controls said transmitting means to retransmit the voice signal to said telephone set by receiving a predetermined signal from said telephone set during transmission of the voice signal by said transmitting means or after transmitting the voice signal. "Once the key pad selects the voicemail

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retrieval routine, the routine replays the stored messages over the telephone," (lines 60-63 of column 3 in Kennedy). It is for this reason that one of ordinary skill in the art at the time of the applicant's invention would have been motivated to have said control means controls said transmitting means to retransmit the voice signal to said telephone set by receiving a predetermined signal from said telephone set during transmission of the voice signal by said transmitting means or after transmitting the voice signal in the system as taught by Baratz.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Monslow et al. (U.S. 4,995,078) discloses a television broadcast system for selective transmission of viewer-chosen programs at viewer-requested times.

Gordon (U.S. 5,608,786) discloses a unified messaging system and method.

Johnson et al. (U.S. 5,813,009) discloses a computer based records management system method.

Hanson et al. (U.S. 5,864,606) discloses a toll free message response.

Albert et al. (U.S. 6,264,614 B1) discloses a system and method for generating and transferring medical data.

Foladare et al. (U.S. 6,330,322 B1) discloses a method and apparatus for updating revertive telephone numbers.

Paksoy et al. ("A variable-rate CELP coder for fast remote voicemail retrieval using a notebook computer") discloses speech coding for voicemail retrieval.

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Anerousis et al. ("TOPS: An architecture for telephony over packet networks") discloses mobility across terminals while being reachable by the same name.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Meucci at (703) 305-1382, or at (571) 272-3899 after October 12th, 2004. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached at (703) 305-9705, or at (571) 272-3896 after October 12th, 2004. The fax phone number for this Group is (703) 308-5358.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [michael.meucci@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Group receptionist whose telephone number is (703) 305-3900.


JACK B. HARVEY
SUPERVISORY PATENT EXAMINER